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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,822	04/12/2001	Donna L. Koenig	7986	5041
1688	7590	01/18/2006	EXAMINER	
POLSTER, LIEDER, WOODRUFF & LUCCHESI 12412 POWERSCOURT DRIVE SUITE 200 ST. LOUIS, MO 63131-3615			TOMASZEWSKI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/833,822	KOENIG, DONNA L.	
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 12 April 2001.

Claims 1-20 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12 recites the limitations "a first location" and "a second location" without distinguishing the difference between the two.

4. Claims 20, referencing Claim 16, recites the limitations "a first pocket" and "a second pocket." There is insufficient antecedent basis for this limitation in the claim. Examiner notes that referencing Claim 17, which recites "a first pocket" and "a second pocket" may be more appropriate.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena that do not apply, involve, use, or advance technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, exemplary claim 1 is drawn to a method for managing a diet for an individual comprising the steps of "providing..." and appears to actively apply,

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involve, use, or advance the technological arts. In particular, these acts are to be performed using “tokens” (i.e., Exchange Cards).

Moreover, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, exemplary claim 1 is drawn to “managing a diet” but no actual management appears to take place in that the claim merely provides the means for management. Put another way, no actual diet management steps are recited. For example, there are no steps involving recording daily caloric intake; devising a diet regimen to achieve a targeted goal; or charting blood sugar levels over the course of a diet regimen.

Although the recited process appears to be within the technological arts, since the claimed invention, as a whole, does not appear to produce a useful, concrete, and tangible result, as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

(B) Dependent claim 2-19 fail to further produce a useful, concrete, and tangible result, and therefore, also fail to pass muster under 35 U.S.C 101.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark (4,976,622; hereinafter Clark).

(A) As per Claim 1, Clark discloses a method for managing a diet for an individual, said method comprising:

- (i) providing a plurality of exchange tokens, each token representing a dietary exchange according to the diet (Clark: col. 1, lines 61-66; Fig. 1-3);
- (ii) providing a first location for placing a total daily allotment of exchange tokens according to the diet (Clark: col. 2, lines 36-38; Fig. 1); and
- (iii) providing a second location to which the exchange tokens are transferred during a day as food is consumed to keep track of food exchanges consumed during the day (Clark: col. 2, lines 38-43; Fig. 1).

(B) As per Claim 2, Clark discloses a method for managing a diet in accordance with Claim 1, said method further comprising:

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- (i) providing a listing of the daily allotment of food exchanges according to the diet (Clark: col. 1, lines 63-66; col. 2, lines 21-24; Fig. 1);
- (ii) instructing the individual to select a group of exchange tokens from the plurality of exchange tokens, wherein the group of exchange tokens corresponds to the daily allotment of food exchanges (Clark: col. 2, lines 27-31; Fig. 2-3);
- (iii) instructing the individual to place the group of exchange tokens representing the daily allotment in the first location (Clark: col. 2, lines 36-38; Fig. 1); and
- (iv) instructing the individual to transfer exchange tokens representing each food consumed from the first location to the second location as the food is consumed during the day (Clark: col. 2, lines 38-43; Fig. 1).

(C) As per Claim 3, Clark discloses a method for managing a diet in accordance with Claim 2 wherein:

instructing the user to transfer individual exchange tokens from the first location to the second location as food is consumed during a day comprises providing the user with a list of foods and their corresponding exchanges according to the diet (Clark: col. 2, lines 20-43; Fig. 1-3).

(D) As per Claim 4, Clark discloses a method for managing a diet in accordance with Claim 1 wherein:

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providing a plurality of exchange tokens comprises providing a plurality of different groups of exchange tokens, each of the groups representing a different food exchange according to the diet (Clark: Fig. 1-3).

(E) As per Claim 5, Clark discloses a method for managing a diet in accordance with Claim 1 wherein:

providing a plurality of exchange tokens comprises providing a plurality of Exchange Cards (Clark: Fig. 1-3).

(F) As per Claim 6, Clark discloses a method for managing a diet in accordance with Claim 5 wherein:

providing a plurality of Exchange Cards comprises providing a plurality of different groups of Exchange Cards, each of the groups representing a different food exchange according to the diet (Clark: Fig. 1-3).

(G) As per Claim 7, Clark discloses a method for managing a diet in accordance with Claim 6 wherein:

providing a plurality of different groups of Exchange Cards comprises providing a group of FRUIT Exchange Cards, a group of MILK Exchange Cards, a group of STARCH Exchange Cards, a group of VEGETABLE Exchange Cards, a group of FAT Exchange Cards, and a group of MEAT & SUBSTITUTES Exchange Cards (Clark: Fig. 2-3).

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(H) As per Claim 8, Clark discloses a method for managing a diet in accordance with Claim 7 wherein:

providing a first location for placing a total daily allotment of exchange tokens according to the diet and providing a second location to which the exchange tokens are transferred during a day as food is consumed to keep track of food exchanges consumed during the day, comprises providing for the first location a first pocket configured to receive the Exchange Cards and for the second location a second pocket configured to receive the Exchange Cards (Clark: col. 2, lines 36-43; Fig. 1).

(I) As per Claim 9, Clark discloses a method for managing a diet in accordance with Claim 8 wherein:

providing the first pocket and the second pocket comprises providing the pockets coupled to a binder to form a booklet (Clark: col. 1, lines 67-68; Fig. 1).

(J) As per Claim 10, Clark discloses a method for managing a diet in accordance with Claim 9 comprising:

providing the booklet in a size adapted to fit into a shirt pocket (Clark: col. 5, lines 67-68).

Examiner also notes that a court held that limitations relating to size are not sufficient to patentably distinguish the prior art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Another court held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a

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device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984).

(K) As per Claim 11, Clark discloses a method for managing a diet in accordance with Claim 9 comprising:

providing the booklet in a size adapted to fit into a jacket pocket (Clark: col. 5, lines 67-68).

Examiner also notes the court holdings from the cases cited within the rejection for Claim 10. See 5. (J), supra.

(L) Claims 12-15 and 17-18 substantially repeat the same limitations of Claims 1, 2, 6 and 9, and are therefore rejected for the same reasons given for those claims.

(M) As per Claim 16, Clark discloses the apparatus in accordance with Claim 15 wherein:

said Exchange Cards are color-coded according to the food group (Clark: col. 4, lines 58-59).

(N) As per Claim 19, Clark discloses the apparatus in accordance with Claim 18 wherein:

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said booklet further comprises a plurality of pages coupled to the binder (Clark: col. 1, lines 67-68).

- (O) Claim 20 substantially repeats the same limitations of Claims 1 and 2, and therefore is rejected for the same reasons given for those claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a food exchanges kit, and methods of constructing and utilizing same (4,689,019 and 4,828,498); a self-standing universal diet card and method for use of same (5,451,079); and a networked health information system for monitoring food intake (US 2004/0107116).

The cited but not applied prior art also includes non-patent literature articles by Amanda Ursell ("Dial a Diet" Jan. 17, 1999. Sunday Times. pg. 36.) and Craig LaBan ("Power Lunch Packs a Punch" Jun. 20, 1997. Times - Picayune. pg. L.33.).


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT *HA* 8.15.05


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER